

Cigelske Jr.

U.S. Serial No. 10/065,582

REMARKS

In the Office Action mailed August 19, 2003, the Examiner has identified three groupings of claims, Group I containing claims 1-4, Group II containing claims 5-10, and Group III containing claims 11-19. Applicant sought reconsideration of the restriction requirement and elected claims 11-19 with traverse in the Election Response filed September 18, 2003. In the body of the most recent Office Action dated September 24, 2003, contrary to the Office Action Summary, the Examiner made the restriction final by only examining those claims previously elected.

Applicant presented arguments in the Election Response filed September 18, 2003 in support of rejoinder of claims 1-10 in light of the precursory examination of elements of the claims as well as the similarities between the claim groups. In imposing the three-way restriction, the Examiner states that Groups I, II, and III are unrelated because the "different inventions" have different effects. The Examiner categorized the claims in groups stating that Group I is drawn to a louver assembly, Group II is drawn to a welding apparatus, and Group III is drawn to a vent assembly. Applicant finds it apparent that the Examiner improperly based his conclusion that the claims in question have different effects based merely on the preamble of the independent claims of each alleged group.

Applicant fully addressed the restriction in the Election and Amendment filed September 18, 2003. The Examiner did not respond to the detailed reasoned explanation from Applicant setting forth why the restriction was not proper. In response to Applicant's arguments, the Examiner chastised Applicant stating that "Applicant's representatives should know there is a difference between positively claiming an apparatus and stating an intended use because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." While "Applicant's representative" is well aware of the requirements of patentability, the Examiner's response is not relevant for restriction practice, nor has Applicant claimed an intended use. Claim 13 calls for, in part, a welder. Additionally, if such is the case, the Examiner's own position requires withdrawal of the restriction because the Examiner is arguing that there is no independently patentable distinction between the "groups".

The intended use notwithstanding, an examination of each of the claims in each of the Examiner's "groups", and the elements that are called for therein, makes it apparent that the restriction is not proper. The Examiner states that "if the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making,

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the intended use must result in a manipulative difference as compared to the prior art." If such is the case, and the Examiner considers claim 13 to be merely intended use, the Examiner has concluded that there is no patentable distinction between the claim groups. As such, the restriction therebetween is clearly improper.

"Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have ... different effects." Emphasis added. MPEP §806.04(A). In imposing the restriction, the Examiner has not shown that the louver assembly of Group I (not just one claim picked from the group, but the entire group), the welding apparatus of Group II, and the vent assembly of Group III are not disclosed as capable of use together. In fact, the louver or vent assemblies of Groups I and III are both actually disclosed as capable of use with the welding apparatus of Group II. The relation between the louver assembly of Group I or the vent assembly of Group III to the welding apparatus of Group II is disclosed and shown as such in the specification. Specifically, Fig. 1 shows a welding apparatus that utilizes the louvered vent assembly of the present invention. Additionally, the relationship is further addressed in paragraph [0025] through paragraph [0029] of the Detailed Description which discusses that which is shown in Fig. 1. Specifically, referring to the welding apparatus 10 shown in Fig. 1, the specification states that "there is a vent opening 28 formed in the front panel 14 of the enclosure 12 and a similar vent opening 30 formed in the rear panel 16 of the enclosure. Within each of the vent openings 28, 30, there are formed a plurality of louvers 32..." As such, the use together of the louver assembly of Group I and the welding apparatus of Group II or the vent assembly of Group III and the welding apparatus of Group II is disclosed in the specification. Therefore, restriction of Group II, containing claims 5-10 from Group I, containing claims 1-4, and Group III, containing claims 11-19, is not proper as the relationship therebetween is fully supported in the specification as stated above. Taken with the Examiner's own statement that the claims differ only in "intended use", then it is apparent that the restriction is not sustainable.

As stated in MPEP §808, "Every requirement to restrict has two aspects: (A) the reasons *(as distinguished from the mere statement of conclusion)* why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween ..." The Examiner, by categorizing the claims merely on the basis of preamble language, has not provided Applicant with any reason why the inventions as claimed are independent. As such, Applicant requests rejoinder of all of the claims of the application.

Enclosed is a Credit Card Authorization that includes the necessary \$130.00 for the Petition fee associated herewith.

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Applicant appreciates consideration of these Remarks and cordially invites the Supervisory Authority to call the undersigned, should any matters be unresolved or if discussion will further prosecution.

Respectfully submitted,



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Dated: December 18, 2003
Attorney Docket No.: ITW7510.031

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